

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-20 are currently pending in the application. Claims 1, 14, and 16 have been amended. No claims have been added or canceled. No new matter has been added by the amendments. Therefore, claims 1-20 are present for examination. Claims 1, 14, and 16 are independent claims.

Abstract

[The abstract has been amended, rendering the objection moot.]

Claim Rejection Under 35 U.S.C. 101

Claims 14-15 and 19-20 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims have been amended to render this rejection moot.

Claim Rejections Under 35 U.S.C. 102

Claims 1-20 were rejected under 35 U.S.C. § 102(b) based upon a public use or sale of the invention. Applicants respectfully request reconsideration of the rejection because either the Examiner has failed to show a *prima facie* case of anticipation or the amendments overcome the rejection. Indeed, “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.” See MPEP §706.02, Original Eighth Edition, August, 2001, Latest Revision July 2008.

The Office Action does not note the specific components of the ATP system stopping synchronization.

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each

reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)(2)

Indeed, an Examiner must identify “each and every facet or the claimed invention is disclosed in the applied reference,” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990), to establish a *prima facie* case of anticipation. Each claim element in the cited reference must be identical to the element in the claim. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). Failure to mention even one claimed element in a prior art reference is enough to “negate anticipation by that reference.” *Atlas Powder Co. v. E.I. DuPont De Nemours & Company*, 750 F.2d 1569, 1574 (Fed. Cir. 1984).

The Examiner has attempted to piece together a rejection from information provided to the Examiner while ignoring important aspects of that provided information. Notably, the product disclosed and sold simply does not embody the claims. Rather, the product does not include one or more elements of the claims. In particular, the product does not include the following claim element from claim 1:

“after the new supply plan is created, synchronizing the new supply plan by processing orders from the first plurality of customer requests scheduled against the current supply plan into the new supply plan, wherein the synchronizing process is stopped prior to synchronizing all the orders in the first plurality of requests into the new supply plan; thereafter, temporarily stopping promising orders while synchronizing all remaining orders from the first plurality of requests not synchronized during the synchronizing process into the new supply plan; and after the remaining orders from the first plurality of requests are processed, replacing the current supply plan with the new supply plan so that the ATP system processes future customer requests against the new supply plan.”

The product does not include the following claim elements from claim 14:

“synchronizing a first portion of the first plurality of requests between the first supply plan and the new supply plan;

stopping synchronization after synchronizing the first portion of the first plurality of requests between the first supply plan and the new supply plan;

temporarily stopping processing orders while processing a second portion of the first plurality of requests between the first supply plan and the new supply plan and while processing the second plurality of requests;
invalidating the first supply plan and activating the new supply plan;
receiving a third plurality of requests from customers, wherein the third plurality of requests is received after the second plurality of requests; and
promising orders from the third plurality of requests against the new supply plan.”

The product does not include the following claim element from claim 16:

“(iii) after the new supply plan is created, synchronizing orders from the first plurality of customer requests scheduled against the current supply plan into the new supply plan by processing a first subset of the plurality of customer requests against the new supply plan until a threshold number of orders in the first plurality of requests is reached;

(iv) thereafter, temporarily stopping promising orders from new customer requests received at the ATP system while checking all remaining orders from the first plurality of requests not checked during the synchronizing process against the new supply plan; and

(v) after the remaining orders from the first plurality of requests are processed, switching the new supply plan for the current supply plan so that the ATP system can process future customer requests against the new supply plan.”

Applicants respectfully request the Examiner to demonstrate where, in the information provided, these claim elements are disclosed. Indeed, the Applicants have specifically averred that these claim elements were not present in the product sold.

Next, claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0152104 A1 issued to Ojha et al. (“**Ojha**”). Applicants respectfully request reconsideration of the rejection because either the Examiner has failed to show a *prima facie* case of anticipation or the amendments overcome the rejection. Indeed, “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.” See MPEP §706.02, Original Eighth Edition, August, 2001, Latest Revision July 2008. Ojha does not disclose all the elements of the claims.

The Office Action does not note the specific components of the ATP system stopping synchronization. The Examiner must show a beginning of synchronization, a stopping of synchronization, a stopping of processing of orders, the restart of synchronization while orders processing is stopped, the end of synchronization, then the restarting of order processing.

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)(2)

Indeed, an Examiner must identify “each and every facet or the claimed invention is disclosed in the applied reference,” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990), to establish a *prima facie* case of anticipation. Each claim element in the cited reference must be identical to the element in the claim. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). Failure to mention even one claimed element in a prior art reference is enough to “negate anticipation by that reference.” *Atlas Powder Co. v. E.I. DuPont De Nemours & Company*, 750 F.2d 1569, 1574 (Fed. Cir. 1984).

Ojha is also not an appropriate anticipatory reference because Ojha does not show the claimed limitations as arranged. “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed *but also all of the limitations arranged or combined in the same was as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net Moneyin, Inc. v. Verisign, Inc.*, No. 2007-1565 (Fed. Cir. decided October 20, 2008), pp. 17-18. Further, the prior art reference must disclose the claimed invention “or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Id.*, p. 19 (citing *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972)). Here, the Examiner has cited sections of Ojha describing different embodiments. The Examiner is required to point to the one embodiment

describing all the claimed elements as arranged in the claim. Since the Examiner has failed to make such a finding, the rejection is improper. Therefore, claim 1 is allowable over the cited art for at least these reasons. To enlighten the following argument, the Applicants will reference one embodiment in Ojha, namely, the description provided for Fig. 5 of Ojha.

Missing Limitation: “wherein the synchronizing process is stopped prior to synchronizing all the orders in the first plurality of requests into the new supply plan”

Claim 1 requires “wherein the synchronizing process is stopped prior to synchronizing all the orders in the first plurality of requests into the new supply plan.” The Examiner states that Ojha teaches this limitation. *See Office Action*, p. 6. Specifically, the Examiner points to step 216 of Fig. 5 of Ojha. *Id.* The section of Ojha describing step 216 states:

Replacement primary HA system 20a' instructs operating HA systems 20 (either individually or through primary HA system 20a) to terminate operation at step 216. At step 218, HA systems 20 terminate operation and generate a stop record indicating the last order that was processed and/or the time of the termination. At substantially the same time as the post-extraction orders are processed by replacement primary HA system 20a' and the termination order is sent, HA systems 20' become operational at step 220 and take over for HA systems 20 (for example, become ready to process product orders, inquiries, and other appropriate requests). It is possible that primary HA system 20a may process a small number of product orders during or after the time that the stop record is published (for example, product orders that were already being processed when primary HA system 20a was instructed to terminate operation). Therefore, at step 222 the new operating primary HA system 20a' may process or replay (as in step 214) any remaining pre-termination orders that were already processed by primary HA system 20a and update the HA supply information in ATP systems 20' accordingly.

Ojha, ¶ [0050] (*emphasis added*).

This recitation does not describe the same thing as the claim element. In the cited section, order processing is stopped by all HA systems. This processing is not synchronization, but real-time processing. Ojha clearly shows that synchronization process continues through all orders before bringing the replacement HA system online. See Ojha, ¶ [0049] (“At step 214, primary HA system 20a' processes or replays the product orders or other appropriate information, as described above in relation to FIGS.

2A and 2B, and updates the ATP supply information stored at primary HA system 20a'). Further, the synchronization process continues through all the orders, not a portion of the orders, and does not stop. Finally, step 216 is the issuance of a stop directive and is not the actual step where processing is stopped (that occurs in step 218). See Ojha, ¶ [0050] (*"Replacement primary HA system 20a' instructs operating HA systems 20 (either individually or through primary HA system 20a) to terminate operation at step 216. At step 218, HA systems 20 terminate operation and generate a stop record indicating the last order that was processed and/or the time of the termination."*). As such, Ojha describes a synchronization process very different than that claimed and does not describe this element of claim 1. For at least the reasons described above, claim 1 is allowable over Ojha.

Claims 2-13:

Claims 2-13 depend, either directly or indirectly, from allowable independent claim 1. Therefore, claims 2-13 are allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claim 14:

Amended claim 14 contains elements similar to claim 1. While the Examiner rejects the claim under 35 U.S.C. § 103, the Examiner relies on Ojha. However, claim 14 includes "the synchronization program stopping synchronization after synchronizing the first portion of the first plurality of requests between the first supply plan and the new supply plan." As such, for at least the reasons recited above in conjunction with allowable claim 1, Claim 14 is also allowable over the cited art.

Further, it appears that the Examiner is taking Official Notice on page 13 of the Office Action. So as not to waive any rights, the Applicants assert that the Examiner is using personal knowledge in taking Official Notice. Therefore, Applicant requests an affidavit from the Examiner in conformance with 37 CFR 1.104 to support the Examiner's assertion that the material of claim 14 was well known. Affidavits have not been provided. Applicants are entitled to such Affidavits upon request in conformance with 37 CFR 1.104 and M.P.E.P. §

2144.03. Therefore, in view of the Examiner's failure to provide such Affidavits, the Office has failed to establish a *prima facie* case of unpatentability.

The request for an Affidavit from the Examiner is appropriate to support the assertions of Official Notice that were taken in the Office Action. Official Notice was taken without referring the Applicants to any well-known text or references. Applicants properly take issue with the Examiner's assertion of Official Notice by noting that the Examiner has not relied upon references that are "old" or "well-known" or "standards" in the pertinent art in order to support the taking of Official Notice. Rather, no reference has been cited in support of the Official Notice. The MPEP is quite clear that use of such references must be old and standard references. *See, e.g.*, M.P.E.P. § 2144.03 where it cites *In re Ahlert* for the proposition that "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." *Ahlert*, 424 F.2d at 1091.

Claim 15:

Claim 15 depends from allowable independent claim 14. Thus, claim 15 is also allowable over the cited art due, at least in part, to this dependence.

Claim 16:

Claims 12, 13 and 16-18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Ojha reference as applied to claim 1, and further in view of U.S. Publication No. 2002/0072988 A1 to Aram ("**Aram**"). Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. *See, e.g.*, *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (*citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). The Examiner must then provide an explicit analysis supporting the rejection. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious

merely by demonstrating that each of its elements was, independently, known in the prior art"). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Examiner to demonstrate that all the claim elements are shown in the prior art. *See* MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision July 2008.

The combination of Ojha and Aram does not describe all the limitations of the claims. Claim 16 contains elements similar to allowable independent claim 1. For example, claim 16 includes "temporarily stopping promising orders from new customer requests received at the ATP system while checking all remaining orders from the first plurality of requests not checked during the synchronizing process against the new supply plan." As such, for at least the reasons recited above in conjunction with claim 1, Claim 16 is also allowable over Ojha. The Examiner does not state that Aram teaches these elements. As such, claim 16 is allowable over the combination of Ojha and Aram.

Claims 17-20:

Claims 17-20 depend, either directly or indirectly, from allowable independent claim 16. Therefore, claims 17-20 are allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any objection, rejection, or argument not specifically addressed herein. Rather, the Applicants believe the amendments and arguments contained herein overcome all objections, rejections, or arguments.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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